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PATENT  
CUSTOMER NUMBER, 22,852  
Attorney Docket No. 01064.0011-05000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE #16 pm  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

08.19.02

In re Application of: )  
Richard LEVY ) Group Art Unit: 1714  
Serial No.: 09/359,809 ) Examiner: M. Medley  
Filed: July 21, 1999 )  
For: LUBRICANT COMPOSITIONS AND )  
METHODS )

Commissioner for Patents and Trademarks  
Washington, DC 20231

Sir:

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**APPELLANT'S BRIEF ON APPEAL PURSUANT TO 37 C.F.R. § 1.192**

Appellant submits the following brief in triplicate, accompanied by the fee required by 37 C.F.R. § 1.17(c), and extends the time for reply by two months with the attached petition for an extension of time and the extension fee. The brief sets forth the authorities and arguments on which appellant will rely to maintain the appeal.

(1) Real Party Interest

The inventor assigned the parent application Serial No. 08/487,436, filed June 7, 1995 to Lee County Mosquito Control District. The assignment was recorded at reel 7878, frame 0620 on August 23, 1995, which makes Lee County Mosquito Control District the real party in interest.

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(2) Related Appeals and Interferences

Appellant has co-pending appeals before the Board of Patent Appeals and Interferences in the following related applications:

Serial No. 08/943,123	Filed October 3, 1997
Serial No. 08/943,125	Filed October 3, 1997
Serial No. 09/779,588 <i>to stay</i>	Filed February 9, 2001
Serial No. 09/357,957	Filed July 21, 1999

The Patent and Trademark Office (PTO) has labeled the cover of their file for application Serial No. 08/943,125 as follows:

U. S. PATENT AND TRADEMARK OFFICE  
RETURN TO (PTO 1056)  
INTERFERENCE SERVICE BRANCH  
This case is involved in an  
Interference Proceeding

Appellant attaches as Exhibit 1, a photocopy of the certified copy of the PTO cover of this application Serial No. 08/943,125. The Patent Office has not notified appellant that they have declared an interference in any of the foregoing applications, even though they indicated on the file of application Serial No. 08/943,125 "[t]his case is involved in an Interference Proceeding." The Board also took the position, when contacted by appellant's attorneys by telephone, that the Patent Office had not declared an interference, in application Serial No. 08/943,125. Lastly, the Board's decision in the pending appeal could directly affect, or be directly affected by, or having a bearing on the decision in the co-pending appeals.

Appellant calls the Board's attention to the United States Patent Application of Martin C. Flautt et al., Serial No. 09/190,866 filed November 13, 1998. Appellant advised the Examiner that appellant's Application Serial No. 09/779,588 copies claims

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from the corresponding Flautt et. al. PCT Application WO 00/29486. The Patent and Trademark Office, as of the filing of this brief, has not declared an interference between appellant's Application Serial No. 09/779,588. and Flautt et. al., Serial No. 09/190,866.

Appellant also calls the Board's attention to the United States Patent Application of Serge Rebouillat et. al., Serial No. 09/443,695 filed November 19, 1999. Appellant advised the Examiner that appellant's Application Serial No. 09/779,559, filed February 9, 2001 copies claims from the corresponding Rebouillat et. al. PCT Application WO 00/31752. The Patent and Trademark Office, as of the filing of this brief, has not declared an interference between appellant's Application Serial No. 09/779,559 and Rebouillat et. al., Serial No. 09/443,695.

(3) Status Of Claims

Appellant submitted a preliminary amendment on July 23, 1999 at the time of filing the present application which added claims 57-71 and cancelled claims 2-56. Appellant's September 5, 2001 response amended claims 1, 57, 59, 62-66, 69, and 71. Claims 1 and 57-71 comprise the claims in the Application as of the filing of the Notice of Appeal in this Application on April 10, 2002 after the Examiner finally rejected the application on April 4, 2002.

(4) Status Of Amendments

The Examiner has entered all amendments to the claims.

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(5) Summary Of Invention

The invention comprises a process of making a lubricant and a lubricant composition of matter consisting essentially of a product produced by a process (written description, page 21, lines 6-8.) of combining a superabsorbent polymer that absorbs greater than about 100 times its weight in water with a material for decreasing friction between moving surfaces where the material is a petroleum oil lubricant, or grease thereof, a solid inorganic compound, a solid organic compound, water containing a lubricant additive, a phosphate, a fatty oil, fatty acid or wax, a synthetic oil lubricant, or grease thereof, or a soap, and mixtures thereof. The lubricant additives include without limitation, an oxidation inhibitor, a rust inhibitor, anti-wear agent, detergent-dispersant, pour-point depressant, viscosity-index improver or foam inhibitor. (Written Description, paragraph bridging pages 19 and 20, and page 20, first full paragraph.)

(6) Issues

The issues on appeal are:

1. Whether the written description enables claims 1 and 57-71, and supports these claims under 35 U.S.C. §112, first paragraph;
2. Whether the subject matter of claims 1 and 57-71 convey to the skilled artisan that appellant had possession of the invention at the time he filed the application as required by 35 U.S.C. §112, first paragraph;
3. Whether claims 1 and 57-71 particularly point out and distinctly claim the subject matter of the invention as required by 35 U.S.C. §112, second paragraph, where these claims use the conjunction "and" in lieu of the conjunction "or" in the Markush terminology employed in these claims;

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4. Whether Hopkins, Jr., United States Patent No. 5,362,766 et al. ("Hopkins") combined with The Merck Index and the admitted prior art anticipates claim 1 under 35 U.S.C. §102(b);
5. Whether the admitted prior art, Levy, United States Patent No. 4,985,251 combined with Brannon-Peppas anticipate claims 1, 57, 63, and 70 under 35 U.S.C. §102(b);
6. Whether Sayad et al., United States Patent No. 3,336,225 ("Sayad") combined with the admitted prior art in view of Hopkins and Geursen et al., WO 93/182,263, and its counterpart United States Patent No. 5,534,304 ("Geursen") support the Examiner's rejection of claims 1, 57, 63-64, and 69-71 under 35 U.S.C. § 103(a);
7. Whether the references relied on by the Examiner in the 35 U.S.C. § 103(a) rejection of claims 1, 57, 63-64, and 69-71 combined with Shey and Booser support the Examiner's rejection of claims 58-62 and 65-68 under 35 U.S.C. §103(a);
8. Whether the Examiner can provisionally reject claims 57-71 under the judicially created doctrine of obviousness-type double patenting in view of claims 29-43 of copending application Serial No. 09/357,957.

(7) Grouping Of Claims

Claims 1 and 57-71 do not stand or fall together. Appellant will demonstrate the separate patentability of the claims in the subsequent Argument.

(8)(a) Argument

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**The Rejections Under 35 U.S.C. § 112, First Paragraph**

**1. The Written Description Enables Claims 1 and 57-71**

The Examiner rejects claims 1 and 57-71 for not including the steps for manufacturing appellants' lubricant, such as mixing the lubricant into the superabsorbent polymer prior to or after exposing it to water or high humidity.

The Examiner perceives these steps as critical or essential to the practice of the invention, but not included in the claims. Although the written description describes this method for manufacture of the compositions of the present invention at pages 28-29, the disclosure also describes the invention broadly.

The Manual of Patent Examining Procedure (M.P.E.P.) addresses this type of rejection as follows:

In determining whether an unclaimed feature is critical, the entire disclosure must be considered, features which are merely preferred are not to be considered critical.

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.

M.P.E.P. § 2146.08 (c)(citations omitted) (emphasis added).

Appellant points out in this respect, that the written description at pages 33-36 illustrate five methods for combining the superabsorbent polymer with a lubricant, without confining the invention to the method the Examiner refers to in the April 4, 2002, Office Action (Paper No. 12).

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Even though the Examiner focuses on the last three paragraphs on page 31 of appellant's written description regarding one of several methods of making the composition (see, for example, pp. 35-36), this does not constitute the only method. Page 35 of the written description in this regard describes admixtures of superabsorbent polymers and lubricants or lubricant formulations which comprise agglomerated water-free compositions. The written description goes on to describe the procedure for forming these admixtures as mixing one or more superabsorbent polymers with one or more solid and/or liquid lubricants with or without additional lubricating additives, and agglomerating the homogenous or hethrogenous admixture compositions at various humidities, pressures, temperatures and the like by standard techniques to form solid unified pellets.

Page 36 further describes the process of admixing agglomerated or non-agglomerated superabosrbent polymer-base lubricant compositions with cross-linking agents to impart different binding, release, coating, swelling or other structural or matrix characteristics to the solid lubricant compositions. At a minimum, appellant has described methods of combining the superabsorbent polymer with a lubricant in a non-aqueous environment, particularly by the procedure described on page 36 of admixing non-agglomerated superabsorbent polymer-based lubricant compositions with cross-linking agents to impart different binding, release, coating and other properties to solid lubricant compositions.

As stated in M.P.E.P. § 2164.08(c) the Examiner focusing on this aspect of the disclosure ignores the entire disclosure, which she must consider. The Examiner has also failed to take into account the broad language at pages 33-36 in the disclosure

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describing other methods of making the composition which omits, or makes no reference to the feature on page 31 that she refers to in her April 4 Office Action.

**2.     The Appellant Was In Possession Of The Invention Of  
Claims 1 and 57-71 at the Time He Filed the Application**

The Examiner rejects claims 1 and 57-71 under 35 U.S.C. § 112 first paragraph allegedly as containing subject matter not described in the specification in such a way so as to reasonably convey to one skilled in the relevant art that the appellant had possession of the claimed invention at the time he filed the application. The Examiner argues that claim 57 and the claims depending from claim 57 focus on mixtures of materials for decreasing friction, whereas the first full paragraph on page 18 of the application describes "each individually." (April 4 Office Action, page 3 first full paragraph.)

The application supports claims to "mixtures" of lubricants. Appellant points out in this regard that in addition to the lubricants on page 18, the written description describes lubricants at pages 6 through the end of page 18, such as petroleum lubricants, synthetic lubricants, greases, and solid lubricants in addition to the metal working lubricants on page 18, and other lubricants also disclosed on page 18. The first full paragraph on page 23 as well as the second and third paragraphs on page 23 then summarize the classes of lubricants employed according to the invention, concluding with the statement that "mixtures of each of the foregoing lubricants may be used including mixtures of two to about three or about four lubricants." (Emphasis added). The application therefore includes "mixtures of lubricants."

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3. The Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 1 and 57-71 under 35 U.S.C. § 112 second paragraph allegedly as indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. The Examiner specifically focuses on the language of claims 1 and 57 employing the phrase "and mixtures

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thereof" arguing that the phrase makes the Markush Group improper. The Examiner suggests employing the conjunction "or" in lieu of "and."

The Manual of Patent Examining Procedure (M.P.E.P.) § 2173.05(h) p. 2100-151 (Rev. 1, Feb. 2000) last paragraph, shows the Patent Office approves either conjunction and the interchangeability of these conjunctions by indicating "[f]or example 'wherein R is a material selected from the group consisting of A, B, C and D' is a proper limitation, then 'wherein R is A, B, C, or D' shall also be considered proper." (Emphasis added). The Examiner by accepting the conjunction "or" implies that the conjunction "and" is acceptable as well. Accordingly, appellant has not amended the claims as suggested by the Examiner.

Appellant also believes use of the conjunction "or" would create confusion relative to the part of the claim that describes the lubricants as including "mixtures," since the Court of Appeals for the Federal Circuit has recently interpreted "or" to exclude combinations of elements in a claim. The court indicated the conjunction "and" would have avoided this interpretation. Kustom Signals, Inc. v. Applied Concepts, Inc., 264 Fed. 3rd 1326, 1331, 60 U.S.P.Q. 2nd 1135, 1138 (Fed. Cir., 2001).

4. **The Rejection Under 35 U.S.C. § 102(b)**  
**Claim 1 Is Not Anticipated**

The Examiner rejects claim 1 under 35 U.S.C. §102(b) as anticipated by Hopkins combined with The Merck Index and the admitted prior art. Hopkins describes a method for combining a superabsorbent polymer with a "matrix" material such as cellulose acetate, methacrylate polymers, polyvinyl acetate, copolymers and

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combinations of these polymers. (Hopkins, col. 1, lines 29-35; col. 2, lines 10-19). The "matrix" material further includes "plasticizers" (col. 2, line 23) which, the skilled artisan knows increases the flexibility of the matrix material, i.e., cellulose acetate, methacrylate polymers, polyvinyl acetate, copolymers and combinations of these polymers.

Webster's Ninth New Collegiate Dictionary defines "matrix" as a "material in which something is enclosed or embedded (as for protection or study)." Hopkins obviously uses the matrix to envelop particles of the superabsorbent polymer in describing the invention as "providing a matrix material in a suitable solvent; mixing particles of a superabsorbent polymer into said solutioned [sic] matrix material to form a suspension; homogenizing the suspension; and removing the solid from the suspension." (Col. 1, lines 30-35) (emphasis added). The foregoing description clearly conveys that Hopkins only dissolves the matrix in a solvent and not the superabsorbent polymer, but rather mixes particles of the superabsorbent polymer into the solution of the matrix in the solvent to form a "suspension."

In fact, Hopkins defines the term "suspension" as a "mixture containing a substantially uniform distribution of solute and particulate matter through the liquid carrier." (Col. 2, lines 30-33). There can be no doubt that Hopkins by referring to the "particles of a superabsorbent polymer" in this section, further confirms the end product comprises a matrix of materials such as cellulose esters that envelop particles of superabsorbent polymer.

The subsequent disclosure relative to the plasticizers clearly teaches that these plasticizers combine with the matrix material and not with the superabsorbent polymer. Hopkins in this regard states that the "matrix material may further comprise additives [such as] plasticizers . . . ." (Col. 2, lines 19-23).

Thus the addition of plasticizers such as glycerin to the Hopkins composition addresses the need to plasticize the matrix material and in no way would teach a person with ordinary skill in the art that the plasticizers combine with the super absorbent polymer.

The examples describe adding a solution of cellulose acetate in acetone in combination with a superabsorbent polymer (Sanwet<sup>®</sup> IM-1000) and glycerin (a plasticizer) to a high shear mixing apparatus to form a solution, which when subsequently cast into films and air dried retains a 0.9% saline solution. Although Hopkins combines a superabsorbent polymer with acetone in the examples, the skilled artisan knows that acetone will not dissolve superabsorbent polymers such as Sanwet<sup>®</sup> IM-1000, and that in essence the combination of acetone and superabsorbent polymer comprises a slurry of particles of the superabsorbent polymer in the acetone in order to facilitate introducing it into the solution of cellulose acetate. Furthermore, Hopkins had no awareness of any lubricating properties of the combination of cellulose acetate or other matrix materials with a superabsorbent polymer.

Hopkins fails to teach a utility for the combination of superabsorbent polymer and matrix material. The reference describes the matrix material as having good absorbent and retention properties and further immobilizes the superabsorbent polymer. (Col. 1, lines 18-19). Hopkins further indicates the matrix materials "can be made porous as would be desirable for filtration membranes." (Col. 1, line 66, Col. 2, lines 7-9).

The reference constitutes nonanalogous art in that it fails to teach anything about the formation of a lubricant or the use of the disclosed material for the purpose of lubrication. Appellant does not rely on the "consisting essentially of" terminology in the claims to distinguish Hopkins.

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The Merck Index confirms that the prior art describes glycerin as a lubricant as well as a plasticizer, but Hopkins only uses it to plasticize the matrix, and doesn't combine glycerin with the superabsorbent polymer, only the matrix. The admitted prior art describes various known superabsorbent polymers, but nothing in the combination of references teaches or suggests making the combination of superabsorbent polymers with a lubricant.

The Examiner appears to have combined the references to reject claim 1, using each teaching of The Merck Index and the admitted prior art individually, and not to amplify the disclosure of Hopkins. The rejection under 35 U.S.C. § 102 (b), therefore is not proper. A 35 U.S.C. §102 rejection sometimes referred to as "anticipation" cannot employ multiple references since a "finding of anticipation requires that all aspects of the claimed invention were already described in a single reference. . . . If it is necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not §102 anticipation, but §103 obviousness." Scripps Clinic v. Genentech Inc., 927 F.2d 1565, 18 U.S.P.Q. 2d 1001, 1010 (Fed. Cir. 1991) (citations omitted) (emphasis added). Here, the Examiner has employed the secondary references to supply additional elements lacking in the principal reference.

**5.                    The Rejection Under 35 U.S.C. § 102(b)**  
**Claims 1, 57, 63 and 70 Are Not Anticipated**

The Examiner rejects claims 1, 57, 63 and 70 under 35 U.S.C. §102(b) as anticipated by the Admitted Prior Art, i.e., Levy, combined with Brannon-Peppas.

Claim 1 describes a process for manufacturing a lubricant composition

by combining a superabsorbent polymer with a material for decreasing friction between moving surfaces wherein said superabsorbent polymer absorbs more than about 100 times its weight in water. The material for decreasing friction is a petroleum oil lubricant or grease, a solid inorganic compound, a solid organic compound, water containing a lubricant additive, a phosphate, a fatty oil, fatty acid or wax, a synthetic oil lubricant, or grease thereof, or a soap, and mixtures thereof.

Claims 57-71 comprise lubricant product by process claims. Claim 57 describes the lubricant as a petroleum oil or grease optionally with a lubricant additive, claim 63 describes it as water containing a lubricant additive and claim 70 as a synthetic oil or grease optionally with a lubricant additive, all of which are in combination with a superabsorbent polymer that absorbs greater than about 100 times its weight in water. The lubricant additives include an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor. Both Brannon-Peppas and Levy fail to teach these additives.

*cl. 57*  
*not*  
*only*  
*Q. 63*  
*70*

The Examiner has also applied Brannon-Peppas in a manner to amplify the Levy disclosure of superabsorbent polymers. Neither Levy nor Brannon-Peppas teach appellant's invention of claims 1, 57, 63 or 70. Importantly, Levy relates to a method and composition for insect and weed control with biological control agents, and not lubrication. Levy does not disclose a petroleum oil lubricant or grease, a solid inorganic lubricant compound, a solid organic lubricant compound, water containing a lubricant additive, a phosphate, a fatty oil, fatty acid or wax, a synthetic oil lubricant, or grease thereof, or a soap, and mixtures thereof as lubricants, let alone biological control agents for insect and weed control. Without teaching these compounds or compositions for

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insect or weed control, the Examiner cannot argue that the reference teaches combining them with a superabsorbent polymer, let alone using the combination in a process for manufacturing a lubricant, or teaching a lubricating product produced by the process. of the claims.

6. **Claims 1, 57, 63-64, and 69-71 Are Not Obvious**  
**Under 35 U.S.C. § 103(a)**

The Examiner rejects claims 1, 57, 63-64, and 69-71 under 35 U.S.C. §103(a) as unpatentable over Sayad combined with admitted prior art in view of Hopkins, and Geursen.

Appellant distinguishes Sayad since the reference only teaches water-soluble acrylamides and not superabsorbent polymers that absorb greater than about 100 times their weight in water. The two polymers are not the same. Superabsorbent polymers swell when combined with water, but do not dissolve in water. Water-soluble acrylamides, as the term implies, dissolve in water. Sayad employs water-soluble acrylamides in combination with an aqueous soap solution in a method for reducing friction on a conveyor, but does not use superabsorbent polymers. In addition, Sayad fails to teach or suggest appellant's lubricant additives with the aqueous soap solution.

The Examiner nonetheless asserts that Sayad discloses a superabsorbent polymer even though she cannot find anything in the reference to support her conclusion. In fact, if Sayad did contain this teaching, the Examiner would not have to resort to combining the teachings of Sayad with other references that specifically describe superabsorbent polymers. The Examiner does not point to anything in this reference that shows Sayad describes superabsorbent polymers. She cannot, since Sayad does not contain this teaching.

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Appellant distinguishes Hopkins for the same reasons given above.

Both Geursen references have the same written description and appellant will refer to U.S. Patent 5,534,304 to discuss the Guersen teachings. Guersen discloses a process for treating a substrate such as a fiber or fibrous product with a superabsorbent material. Geursen, without specifically mentioning it, faces a problem of applying a superabsorbent polymer coating to a substrate from a liquid medium. The superabsorbent polymer employed by Geursen does not dissolve in water, so Geursen forms an emulsion (actually a suspension) of the polymer in water by polymerizing the water soluble monomer in a water in oil medium to form the polymer in the aqueous phase of the emulsion (Col. 4, lines 1-16). Geursen uses the emulsion as a coating, and subsequently heat-treats it to drive off the water phase and oil phase, generally a relatively low boiling paraffin hydrocarbon. (Col. 3, lines 15-23). Geursen also discloses commercially available water-in-oil emulsions prepared in the same way, which may also include additives, such as lubricants and emulsifying agents. (Col. 4, lines 17-26; 42-47).

The disclosed aqueous polymerization of the monomer into a superabsorbent polymer appears to prevent Geursen from obtaining a polymer that absorbs greater than about 100 times its weight in water. The subsequent analysis of the Geursen examples will show that the reference contains experimental data showing the production of superabsorbent polymers that absorb only about 45 times their weight in water. Geursen therefore lacks an enabling disclosure of how to produce oil in water emulsions of superabsorbent polymers that absorb greater than about 100 times their weight in water.

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The reference describes yarns coated with a superabsorbent polymer composition which have a "swelling value" (Col. 7, lines 19-44) defined by a formula (Col. 7, lines 45-51). The swelling value consists of a number that indicates the relative water absorbency of the yarn or the yarn coated with the superabsorbent polymer composition.

Again, Geursen does not teach or suggest superabsorbent polymers that can absorb greater than about 100 times their weight in water for the process or product disclosed, as an analysis of the data in columns 9 and 10 bears out. Table A, reports experimental data for the swelling values of yarn samples coated with a water-in-oil emulsion where the yarn is a polyester yarn, with the untreated polyester yarn having a swelling value of 9. Using the formula in col. 7, lines 45-51:

$$\text{swelling value} = \frac{(a - b) \times 100}{b}$$

Arbitrarily setting the weight of the yarn (the value for "a") at 100 grams will give the dry weight of the yarn (the value for "b") as follows:

Example 1	Swelling value of <u>uncoated</u> yarn = 9 (Col. 9, lines 34-35)
$\frac{100-b}{b}$	= 0.09
100	= 1.096b
b	= 91.74 (dry weight of yarn)

$$\text{Yarn water absorption} = 100 - 91.74 = 8.26$$

Example 1	Swelling value of <u>coated</u> yarn = 114 (Col. 9, line 28)
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$$\frac{100-b}{b} = 1.14$$

$$100 = 2.146b$$

$$b = 46.72 \text{ (dry wt. of yarn and superabsorbent polymer)}$$

$$\text{Coated yarn water absorption} = 100 - 46.72 = 53.28$$

$$53.28 - 8.26 = 45.02 \text{ water absorbed by superabsorbent polymer}$$

$$46.27 \times 2.1\% \text{ polymer (Col 9, line 28)} = 0.97 \text{ superabsorbent polymer on yarn}$$

$$\frac{45.02}{0.97} = 46.3 \text{ Superabsorbent polymer absorbs 46.3 times its weight in water.}$$

This shows that 0.97 grams of superabsorbent polymer picked up or absorbed 45.02 grams of water or 46.3 times its weight in water, less than one half of that of appellant's claimed superabsorbent polymer which absorbs greater than about 100 times its weight in water. The same calculations will show the superabsorbent polymer of experiment 4 (Table B) coated on a nylon-6,6 yarn absorbs about the same amount of water, i.e., less than about one half appellant's claimed superabsorbent polymer that absorbs greater than about 100 times its weight in water.

These data from Guersen clearly suggest that the inventors did not know how to combine a lubricant with a superabsorbent polymer that absorbs greater than about 100 times its weight in water. Since the reference does not disclose this type of polymer or how to produce it, Geursen does not contain an enabling disclosure.

The Examiner, however, refuses to acknowledge the foregoing analysis, does not articulate why the data have no relevance to the Geursen teachings, but only dismisses them without any reason. Recent case law reiterates that the Examiner cannot do this. She has to give a reason why the preferred data have no relevance.

Cf., In re Lee, No. 00-1158, slip op. at 8 (Fed. Cir., January 18, 2001) ("[w]hen they [the

Board of Appeals] assert general knowledge to negate patentability, that knowledge must be articulated and placed on the record.") (emphasis added).

The Examiner however does state "[i]n responds to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., the swell value of the substrate containing a superabsorbent polymer) are not recited in the rejected claim(s)." (April 4 Office Action, p. 7, par. 2). Appellant does not have to recite features of the Geursen disclosure in the claims of his application. The "swell value of the substrate" only amounts to a feature appellant has focused on to analyze the water absorbency of the Geursen superabsorbent polymer as set out previously in this brief. Appellant claims the water absorbency of the polymer, and shows the Geursen reference does not teach or suggest this water absorbency. Appellant, on the other hand, has recited in all of the claims that the invention on appeal requires a superabsorbent polymer and absorbs greater than about 100 times its weight in water. The examples of Geursen only teach superabsorbent polymer that absorbs about 45 times its weight in water and the recitation in the Geursen written description of superabsorbent polymers that absorb more does not overcome the lack of enablement of Geursen of how to combine these polymers with a lubricant. Appellant, on the other hand, has disclosed methods on how to combine superabsorbent polymers that absorb greater than 100 times their weight in water with lubricants.

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Guersen faced the problem of applying a superabsorbent polymer to yarn, confronted with the difficulty that the superabsorbent polymers when combined with water had extremely high viscosities. The superabsorbent polymer employed, therefore had to have some flowable characteristics in order to apply it as a coating material. Guersen appears to address this problem by adding an electrolyte to the superabsorbent polymer. For example, Guersen, in column 9, lines 8 et. seq. discloses using a sodium salt of the superabsorbent polymer.

Levy, however, discusses this well known technique of reducing the viscosity of a superabsorbent polymer, observing:

normally, unmixed formulations of superabsorbent polymers and water have a tendency to form gels of such a high viscosity that they are not flowable. An additional technique used to render a viscous superabsorbent polymer composition . . . flowable, is the additional [sic, addition] of varying concentrations of one or more salt(s)/electrolyte(s) such as sodium chloride. . . . These salt-s/electrolytes have a tendency to interfere with the hydrogen bonding or reduce the hydrophilic bonding of the water to the gel. Also, superabsorbent polymers . . . absorb less water when electrolytes are present.

Levy, U.S. Patent No. 4,985,251 column 15, lines 12-26 (emphasis added).

This further supports the foregoing analysis of the Guersen data, and that Guersen had to obtain a formulation that he could coat onto a textile fiber, particularly a formulation that did not gel. It appears Guersen did this by adding a sodium salt to the superabsorbent polymer to break the gel, and in so doing obtained a flowable formulation, but reduced the water absorbency of the superabsorbent polymer to a value of about 45 times it's weight in water.

The Examiner also attempts to dismiss this shortcoming of Geursen by arguing "the fact that applicant has recognized another advantage which would flow naturally

from following the suggestions of the prior art cannot be the basis for patentability when the differences would be otherwise obvious." (April 4 Office Action, par. bridging pp. 6 and 7) (citation omitted).

Because Geursen teaches superabsorbent polymers coatings that absorb only about 45 times their weight in water, the reference clearly raises the question of how the skilled artisan gets over the hurdle of this water absorbency of 45 to arrive at appellant's lower limit of water absorbency greater than about 100? The reference clearly lacks an enabling disclosure, and the Examiner has not met the burden of providing evidence that Geursen does in fact show a suspension polymer in an aqueous medium suitable for coating a substrate, where the polymer absorbs greater than about 100 times its weight in water. Lacking this evidence, the rejection cannot stand. In re Lee.

The Examiner admits that appellant's claims differ from the cited references by requiring that the superabsorbent polymer absorbs greater than about 100 times its weight in water. (July 5, 2001 Office Action, p. 7, first full paragraph.) She nonetheless takes the position that the skilled artisan would find it obvious to use a superabsorbent polymer that absorbs greater than about 100 times its weight in water especially in view of the admitted prior art and Hopkins.

Appellant respectfully disagrees since the combined teachings of the references still don't inform the skilled artisan how to combine a lubricant with a superabsorbent polymer that absorbs greater than about 100 times its weight in water. Again, Hopkins only describes a superabsorbent polymer particles enveloped by a plasticized "matrix" based on cellulose acetate, methacrylates or vinyl acetate polymers and copolymers or mixtures thereof, which has to be viewed with Guersen who did not disclose how to formulate a composition with a superabsorbent polymer that absorbs greater than about

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100 times its weight in water. This does not comprise appellant's invention since the claims of the application do not relate to cellulose acetate or other Hopkins polymers that have been softened with a "plasticizer" nor a polymer as taught by Guersen that absorbs only about 45 times its weight in water.

Appellant has shown that in the present invention he can combine a lubricating material with a superabsorbent polymer that absorbs more than about 100 times its weight in water, contrary to Guersen, but that does not limit the appellant's invention to the specific method he discloses for making the combination of superabsorbent polymer and lubricant. Appellant can claim the composition of matter, irrespective of the method employed for obtaining it.

7. Claims 58-62 and 65-68 Are Not Obvious

Under 35 U.S.C. §103(a)

The Examiner rejects claims 58-62 and 65-68 under 35 U.S.C. §103(a) as unpatentable over Sayad combined with Admitted Prior Art in view of Hopkins and Guersen, and further in view of Schey and Booser.

Appellant distinguishes Sayad, the Admitted Prior Art, Hopkins, and Guersen for all the reasons previously set out in this brief. The references to Schey and Booser merely describe lubricant technology that appellant already referred to in Kirk-Othmer Encyclopedia of Chemical Technology, Second Edition, pp. 559-595 in the last paragraph on page 18 of the written description. The various lubricants and lubricating systems described in Schey and Booser only elaborate on the description of the lubricant materials appellant included in the written description.

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### The References Provide No Motivation to Combine Their Teachings

The Examiner "has to point to some teaching, suggestion or motivation in the prior art to select and combine the references that . . . [she] relied on to show obviousness." In re Lee, No. 00-1158 slip op. at 4 (Fed. Cir., January 18, 2001) (emphasis added). "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to select and combine the references relied on as evidence of obviousness... 'the central question is whether there is a reason to combine references.'" Lee, slip op. at 5 (emphasis added) (citation omitted). Appellant submits that the Examiner has not pointed to anything in the cited references that would lead a person with ordinary skill in the art to combine their teachings.

The combination of references does not make applicants' invention obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. Section 2143.01 citing In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2nd 1430 (Fed. Cir. 1990). Also, there must be some reasonable expectation of success (M.P.E.P. Section 2143.02, and cited authorities) and that some advantage or expected beneficial result would have been produced by their combination. (M.P.E.P. Section 2144 citing In re Sernaker, 702 F.2d, 989, 994-95, 217 U.S.P.Q. 1,

In rejecting the claims on a combination of references, the Examiner has Levy teaching a superabsorbent polymer in combination with a bioactive material, Sayad teaching a water soluble polymer and not a superabsorbent polymer in combination with a soap as a lubricant, Hopkins teaching a polymer such as cellulose acetate with a plasticizer, as a matrix for a superabsorbent material, and Geursen teaching a superabsorbent polymer absorbing only about 45 times its weight in water applied to a

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substrate as a water in oil emulsion, followed by removing the oil phase (a paraffinic hydrocarbon) by evaporation.<sup>1</sup> Adding Brannon-Peppas, Schey and Booser to the mix gives the Examiner citations to show the art contains teachings of superabsorbent polymers that absorb greater than about 100 times their weight in water, as well as extensive disclosures of lubricant materials and technology, but appellant disclosed this in the written description when he filed the application. Where then, in all of these references, can a skilled artisan find a teaching, suggestion, or motivation to pick and chose from them, and then combine the pieces to arrive at appellant's invention, that broadly comprises a lubricant in combination with a superabsorbent polymer that absorbs greater than about 100 times its weight in water? Appellant submits the skilled artisan couldn't without appellant's disclosure in front of them.

A 35 U.S.C. § 103 rejection cannot stand if it amounts to taking appellant's "claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

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<sup>1</sup> As pointed out on page 17 of this brief, Geursen couldn't show how to make a superabsorbent polymer that absorbs greater than about 100 times its weight in water in combination with other materials to form the disclosed water in oil emulsion. Geursen lacks an enabling disclosure in this respect.

**The Examiner Has Improperly Relied on Non-Analogous  
Art to Make The Rejection**

By combining the teachings of the various references under 35 U.S.C. § 103, the Examiner has relied on non-analogous art since the references are not related to the same field of endeavor or reasonably pertinent to the problem addressed by the inventor. In re Clay, 966 F.2d, 656, 23 U.S.P.Q. 2d at 1058 (Fed. Cir. 1992).

The Examiner cannot combine Sayad with the other references since Sayad does not teach superabsorbent polymers. Further, the Levy patent relates to biological control agents as well as delivering these biological control agents to a targeted environment. Hopkins also falls into the category of non-analogous art since the reference describes a polymeric matrix for a superabsorbent polymer having no disclosed utility.

A person with ordinary skill in the lubricant art would not consider looking to the biological control arts to develop a product that would fulfill a perceived need in the lubricating arts and vice versa. The combination of references does not relate to the same field of endeavor nor is it "reasonably pertinent to the problem with which the inventor is involved." Clay, 966, F.2d at 658, 23 U.S.P.Q. 2d at 1060. The lubricant arts do not fall into the same field of endeavor as the biological control agents and processes of the Levy patent. Clearly, the Levy biological control agents and processes are not reasonably pertinent to the problem, which the inventor, Dr. Levy is concerned with in the present application, i.e., lubricants and lubricating processes.

The fact that Dr. Levy, the inventor of the present application and the inventor in the Levy patents, has worked in both the fields of bioactive materials and lubricants does not provide the nexus between the superabsorbent polymers/ biological control

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agents and superabsorbent polymers/lubricants. In the first instance, the present application is not prior art that can be used to show the level of skill in a superabsorbent polymer art. More important, the total lack of evidence supporting a relationship between biological control agents and lubricants forecloses any argument that these two areas comprise related fields of scientific or technological endeavor. The similarity has to reside in the nature of the scientific or technological fields, and not the fact that one scientist with multiple disciplines works in both. The inquiry is whether the field of delivering biological control agents to a target area suggests lubricants or vice versa. Clearly, they do not.

I. **The Claims Do Not Stand or Fall Together**

Claims 1 and 57 comprises generic claims to a process for forming a lubricating composition, and a lubricating composition of matter which is a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, and generically sets out various lubricant materials. The balance of the claims directly or indirectly depend on claim 57, however define the superabsorbent polymer as based on acrylic acid, an acrylic ester, acrylonitrile, acrylamide, copolymers thereof or mixtures thereof. In the unlikely event that the Examiner would be able to shown any acrylic resin for this particular application, appellant has the option of rebutting the rejection with data showing why the specific polymers as well as the particular lubricants contained in the claims have new, different, or unexpected properties.

Similarly, claims 58 and 59 differ from one another in that claim 58 sets out petroleum oil lubricants or greases as a lubricant whereas claim 59 sets out solid

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lubricants. Appellant again, in the unlikely event that the Examiner could show the prior art teaches one of the lubricants in combination with the superabsorbent polymers, can show new, unexpected or nonobvious results employing one type of lubricant or polymer as opposed to another.

Claim 60 dependent on claim 59 relates to solid lubricants subgenerically set out in claim 61 and appellant also would have the opportunity to show new, unexpected and unobvious results employing these lubricant materials .

The balance of the claims also stands in the same relationship of subgeneric claims to species claims centered around the particular lubricant. Appellant in each instance has the right to submit evidence to show the species claims have properties that would not be foreshadowed by all of the species that fall into the subgeneric claims from which they depend.

8.

**The Provisional Double Patenting Rejection**

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may be  
different*

The Examiner provisionally rejects claims 57-71 under the judicially created doctrine of obviousness-type double patenting in view of copending application Serial No. 09/357,957 filed July 23, 1999. Appellant points out that the present Examiner has also issued a provisional double patenting rejection in copending application Serial No. 09/357,957, which has not issued as a patent. Appellant should not be required to file a terminal disclaimer in the present application since the Patent Office may not allow the copending application which forms the basis of the double patenting rejection. When a provisional double patenting rejection is the sole remaining rejection in an application otherwise in condition for allowance, the M.P.E.P. states that the Examiner should

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(9) Appendix

Claims on Appeal

1. A process for manufacturing a lubricant composition consisting essentially of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces wherein said superabsorbent polymer absorbs more than about 100 times its weight in water, and said material for decreasing friction is a petroleum oil lubricant or grease thereof, a solid inorganic compound, a solid organic compound, water containing a lubricant additive, a phosphate, a fatty oil, fatty acid or wax, a synthetic oil lubricant, or grease thereof, or a soap, and mixtures thereof.

57. A lubricant composition of matter consisting essentially of a product produced by the process of combining a superabsorbent polymer that absorbs more than about 100 times its weight in water with a material for decreasing friction between moving surfaces, wherein said material for decreasing friction is a petroleum oil lubricant or grease thereof, a solid inorganic compound, a solid organic compound, water containing a lubricant additive, a phosphate, a fatty oil, fatty acid or wax, a synthetic oil lubricant, or grease thereof, or a soap, and mixtures thereof.

58. The lubricant composition of claim 57 consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof,

wherein said material for decreasing friction is a petroleum oil lubricant or grease thereof, and wherein said material for decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

59. The lubricant composition of claim 57 consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is a solid lubricant, wherein said solid lubricant is an inorganic compound, carbon or metal that provides barrier-layer lubrication, and mixtures thereof, and wherein said material for decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

60. The lubricant composition of claim 59, wherein said solid lubricant is graphite, molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, mica, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, borax, basic white lead, lead carbonate, lead iodide, asbestos, talc, zinc oxide, carbon, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, or the Group VIII noble metals or mixtures thereof.

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61. The lubricant composition of claim 57 consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is a solid organic lubricant, and wherein said material for decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

62. The lubricant composition of claim 61, wherein said solid organic lubricant is a fluoroalkylene homopolymer or copolymer, a lower alkylene polyolefin homopolymer or co-polymer, a paraffinic hydrocarbon wax, phenanthrene, copper phthalocyanine, or mixtures thereof.

63. The lubricant composition of claim 57 consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is water containing a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound,

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extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

64. The lubricant composition of claim 57, consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is an oil or greases thereof and water, optionally containing a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

65. The lubricant composition of claim 57, consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is a solid lubricant and water, optionally containing a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

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66. The lubricant composition of claim 65, wherein said solid lubricant is graphite, molybdenum disulfide, cobalt chloride, antimony oxide, niobium selenide, tungsten disulfide, mica, boron nitride, silver sulfate, cadmium chloride, cadmium iodide, borax, basic white lead, lead carbonate, lead iodide, asbestos, talc, zinc oxide, carbon, babbitt, bronze, brass, aluminum, gallium, indium, thallium, thorium, copper, silver, gold, mercury, lead, tin, indium, the Group VIII noble metals, a fluoroalkylene homopolymer or copolymer, a lower alkylene polyolefin homopolymer or co-polymer, a paraffinic hydrocarbon wax, phenanthrene, copper phthalocyanine, or mixtures thereof.

67. The lubricant composition of claim 57 consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is a phosphate, and wherein said material for decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

68. The lubricant composition of claim 67, wherein said material for decreasing friction is zinc phosphate, iron phosphate or manganese phosphate, or mixtures thereof.

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69. The lubricant composition of claim 57 consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is a fatty oil, fatty acid, or wax, or mixtures thereof and wherein said material for decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

70. The lubricant composition of claim 57 consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is a synthetic oil lubricant, or grease thereof, and wherein said material for decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

71. The lubricant composition of claim 57 consisting essentially of a product produced by the process of combining a superabsorbent polymer with a material for

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decreasing friction between moving surfaces, wherein said superabsorbent polymer absorbs greater than about 100 times its weight in water and is a polymer of acrylic acid, an acrylic ester, acrylonitrile, acrylamide, co-polymers thereof or mixtures thereof, wherein said material for decreasing friction is a soap, and wherein said material for decreasing friction optionally contains a lubricant additive, wherein said lubricant additive is an antioxidant, rust inhibitor, antiwear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor.

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withdraw the rejection in the application and permit it to issue as a patent. M.P.E.P. § 804(l.)(B) p. 800 -15 July 1998.

### Conclusions

Appellant requests the Board to reverse the Examiner in all respects and remand the application to the Examiner for the issuance of a Notice of Allowance. If entry of this Brief on Appeal requires an extension of time pursuant to 37 C.F.R. § 1.136 and payment of an extension fee or other fee, any of which this Brief does not account for, appellant's attorneys request such an extension and payment of any fee due from their deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 12, 2002

By: 

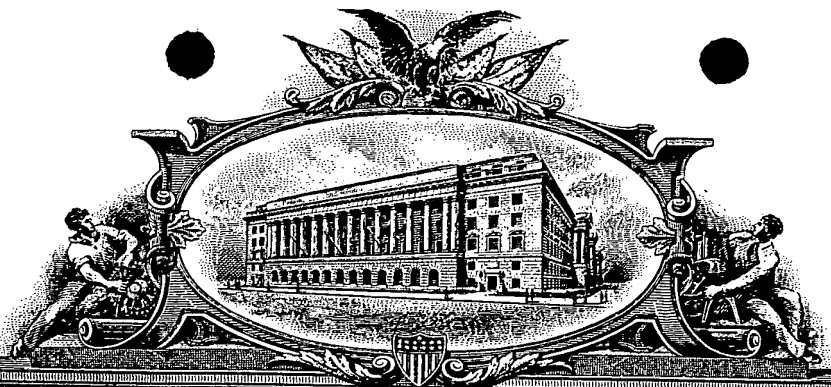
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SUBCLASS 609 110	GROUP ART UNIT 1721	EXAMINER medley

APPLICANTS RICHARD LEVY, MYERS, FL.

\*\*CONTINUING DATA\*\*\*\*\*  
VERIFIED THIS APPLN IS A CON OF 08/487,436 06/07/95  
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TITLE LUBRICANT COMPOSITIONS AND METHODS

U.S. DEPT. OF COMM./PAT. & TM—PTO-436L (Rev.12-84)

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NOTICE OF ALLOWANCE MAILED		CLAIMS ALLOWED	
Assistant Examiner		Total Claims	Print Claim
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Amount Due	Date Paid	Sheets Drawn	Figures Drawn
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# SEARCH NOTES

	Date	Exmr.
Received ABN Parent S.N. 08/487436 for art, seal, ink, stamp and finding 08/943, 123	4/1/98	MBM
Appeal Conference with SPE N. Bell	4/1/99	MBM

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